

### **REMARKS**

In the Office Action mailed February 18, 2009 from the United States Patent and Trademark Office, claims 1-7, 9, 11, and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,332,149 to Warmus et al. (hereinafter “Warmus”) in view of U.S. Patent No. 5,664,178 to Sinofsky (hereinafter “Sinofsky”) and U.S. Patent No. 7,196,803 to Simpson et al. (hereinafter “Simpson”), claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Warmus, Simpson, and Sinofsky further in view of U.S. Patent No. 7,215,434 to Janse et al. (hereinafter “Janse”), claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Warmus, Sinofsky, and Simpson further in view of allegedly well known prior art, claims 13-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Warmus in view of Simpson, Sinofsky, and U.S. Patent No. 6,351,553 to Hayosh, claims 16-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Warmus, Simpson, Sinofsky, and Hayosh further in view of allegedly well known prior art, claims 19-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Warmus in view of Sinofsky, claim 24 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Warmus and Sinofsky in view of Janse, and claim 25 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Warmus and Sinofsky further in view of allegedly well known prior art.

#### **Rejections under 35 U.S.C. § 103(a):**

M.P.E.P. § 2141 sets forth the *Graham* factual enquiries that should be considered when making an obviousness rejection under Section 103: 1) ascertaining the scope and content of the prior art; 2) ascertaining the differences between the claimed invention and the prior art; and 3) resolving the level of ordinary skill in the pertinent art. (Citing *Graham v. John Deere*, 383 U.S.

1, 148 USPQ 459 (1966).) In addition, M.P.E.P. §§ 2141 and 2142 set forth that “the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” (Citing *KSR International Co. v. Teleflex Inc.* (*KSR*), 550 U.S. \_\_\_, 82 USPQ2d 1385 (2007).)

For a rejection under Section 103 to stand, it must explicitly set forth 1) factual findings showing that each claim element was known in the art at the time of the invention, and 2) factual findings showing that one of ordinary skill in the art, at the time of the invention, would have found it obvious to modify or combine the teachings to arrive at the claimed invention. (See, for example, the enumerated required articulations set forth in M.P.E.P. § 2143 for each lettered rationale.) In showing that one of ordinary skill in the art would have found it obvious to combine the teachings of multiple references, it is improper to combine references where the references teach away from their combination. M.P.E.P. § 2145; *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

Applicant respectfully submits that the references in the Office Action, either alone or in combination, do not teach or suggest all the limitations claimed in the claim set provided herein. Applicant also respectfully submits that one of skill in the art would not have found it obvious to combine the cited references to arrive at the claimed invention. Applicant therefore submits that the Office Action has failed to show how one of skill in the art would have found it obvious to overcome the differences between the prior art and the claimed invention to arrive at the claimed invention.

With respect to claim 1 as amended, claim 1 recites that a second sub-image is rendered as a part of a first sub-image rendered as a part of one of the pages of the document. This rendering of sub-images within sub-images is discussed in the application at least at page 19 lines 11-14, and page 21 line 6-page 22 line 2. This rendering of sub-images within sub-images

provides flexibility in rendering document indicia on a rendered document and is not disclosed by the cited references, either alone or in combination. Warmus only discloses the placement of variable information at fixed designated locations (see Figures 6a-8b), and does not disclose sub-images rendered as part of sub-images within images as required by claim 1. Sinofsky also fails to teach such limitations, as Sinofsky only discloses a file bundle containing sub-files (see abstract) and does not disclose sub-images rendered as part of sub-images within images as required by claim 1. None of the other references disclose such limitations. Therefore, claim 1 is not made obvious by the cited references. Claims 2-12 depend on claim 1 and are similarly allowable.

Claim 13 as amended recites providing a single TIFF document to a printer in TIFF format without using a printer driver and selectively rendering the TIFF image at the printer wherein the printer merges the sub-images based on the electronic tags. Although Warmus discloses the use of TIFF documents in the disclosed process (see Col. 23 lines 21-23), Warmus does not disclose a printer receiving a single TIFF document having multiple sub-images and merging the sub-images based on electronic tags in the TIFF document. As discussed above, Sinofsky merely teaches a file bundle containing sub-files, and therefore fails to teach the limitations of claim 13. The other references also fail to teach the limitations of claim 13, and claim 13 is therefore not made obvious by the cited references. Claims 14-18 depend on claim 13 and are similarly allowable.

Claim 19 as amended recites receiving a rendering job of a document as a single file at a rendering device wherein the rendering job is in a native image format that supports at least one of (i) multiple pages, and (ii) multiple images, and wherein the single file of the rendering job contains: one or more document indicia stored as separate sub-images in the single file in the

native image format; one or more images representing one or more pages of the document, wherein the one or more images are defined independently of and are not merged with the one or more sub-images in the single file; one or more tags within the file defining how the one or more pages of the document should be merged with one or more of the sub-images; and an ordered subset of the sub-images to apply to the document; and using a rendering device process, as directed by the tags and without a printer driver, to associate and merge the one or more sub-images with one or more of the pages of the document as directed by the tags when rendering the document, wherein the process is one of (i) an overlay process, (ii) an underlay process, and (iii) a composite process. Such limitations are not taught by the cited references.

None of the cited references, either alone or in combination, teach using a rendering device process at the time of rendering and without a printer driver to associate and merge sub-images with document pages from within a single file as directed by tags within the file for similar reasons to those discussed above with respect to claim 13. Therefore, claim 19 and its dependent claims are not made obvious by the cited references.

One or more of the dependent claims also contain limitations not disclosed in the cited references, and are at least patentable for such additional reasons.

Applicant also respectfully maintains that one of skill in the art would not find it obvious to combine Warmus and Sinofsky in the manner suggested for the reasons that have been previously addressed.


For at least the above reasons, Applicant respectfully requests removal of all rejections under 35 U.S.C. § 103(a).

**CONCLUSION**

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 22 day of June, 2009.

Respectfully submitted,

  
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